

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN Y. PARK, JAMES N. COOK,
DORLA MIREJOVSKY and STEVEN S. MATSUMOTO

Appeal No. 96-1852
Application No. 08/016,931¹

ON BRIEF

Before KIMLIN, GARRIS and PAK, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed February 12, 1993. According to appellants, this application is a continuation-in-part of Application No. 07/698,611, filed May 10, 1991, now abandoned.

Appeal No. 96-1852
Application No. 08/016,931

This is an appeal from the final rejection of claim 1-13 and 15-22, all the claims remaining in the present application. Claims 1, 12 and 13 are illustrative:

1. A method for inhibiting the formation of deposits on a contact lens comprising:

introducing into a mammalian eye wearing a contact lens an ophthalmically acceptable composition comprising an ophthalmically acceptable antioxidant component in an amount effective to inhibit the formation of at least one of proteinaceous deposits and lipid deposits on said contact lens.

12. A method for conditioning a contact lens comprising:

soaking a contact lens which is proteinaceous deposit-free in an ophthalmically acceptable composition comprising an ophthalmically acceptable aqueous carrier component, an ophthalmically acceptable wearability component in an amount effective to enhance the wearability of said soaked contact lens in a mammalian eye, and an ophthalmically acceptable antioxidant component in an amount effective to inhibit the formation of at least one of proteinaceous deposits and lipid deposits on said soaked contact lens after said soaked contact lens is placed in a mammalian eye, said ophthalmically acceptable antioxidant component being selected from the group consisting of Vitamin A, Vitamin E, ascorbic acid, glutathione, oxidation-type glutathione, ophthalmically acceptable antioxidant salts thereof, ophthalmically acceptable antioxidant derivatives thereof, precursors thereof and mixtures thereof.

13. A composition useful for inhibiting the formation of deposits on a contact lens being worn in a mammalian eye comprising:

an ophthalmically acceptable aqueous carrier component;

Appeal No. 96-1852
Application No. 08/016,931

an ophthalmically acceptable wearability component in an amount effective to enhance the wearability of a contact lens in a mammalian eye; and

at least one ophthalmically acceptable antioxidant component in an amount effective to inhibit the formation of at least one of proteinaceous deposits and lipid deposits on a proteinaceous deposit-free contact lens being worn in a mammalian eye, said

Appeal No. 96-1852
Application No. 08/016,931

composition being ophthalmically acceptable and having an ophthalmically acceptable pH greater than 5.0, said ophthalmically acceptable antioxidant component being selected from the group consisting of Vitamin A, Vitamin E, ascorbic acid, glutathione, oxidation-type glutathione, ophthalmically acceptable antioxidant salts thereof, ophthalmically acceptable antioxidant derivatives thereof, precursors thereof and mixtures thereof, said composition being ophthalmically acceptable.

The examiner relies upon the following references as evidence of obviousness:

Ogata	4,285,738	Aug. 25, 1981
Chanda et al. (Chanda)	4,715,899	Dec. 29, 1987

Japanese Abstract JP60254114 (Japanese '114) (1985)

Appellants' claimed invention is directed to a composition useful for inhibiting the formation of deposits on a contact lens, and methods for utilizing the composition on a contact lens while being both worn and not worn. The composition comprises ophthalmically acceptable carrier components, wearability components and antioxidant components.

Appealed claims 1-13 and 15-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over the collective teachings of Chanda, Ogata and Japanese '114.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we

Appeal No. 96-1852
Application No. 08/016,931

concur with appellants that the prior art presented by the examiner fails to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, for essentially those reasons expressed by appellants in their Brief, we will not sustain the examiner's rejection.

The examiner does not dispute appellants' characterization of the prior art as teaching compositions and methods of removing protein deposits on soiled contact lenses with compositions that are not ophthalmically acceptable. Rather, it is the examiner's position that to modify a prior art composition to render it ophthalmically acceptable and to use it to inhibit the formation of proteinaceous material instead of removing such material are "within the skill of the artisan" (page 5 of Answer). However, the fatal flaw in the examiner's reasoning is that the proper test for obviousness under 35 U.S.C. § 103 is not what one of ordinary skill in the art could have accomplished if he was inclined to do so, but, rather, does the prior art provide a teaching or suggestion of the claimed invention. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fully agree with appellants that none of the applied prior

Appeal No. 96-1852
Application No. 08/016,931

art, either singularly or collectively, teaches or suggests inhibiting the formation of deposits on a contact lens by utilizing a composition comprising the recited ophthalmically acceptable components. Accordingly, we are constrained to reverse the examiner's rejection.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection. Claims 13 and 15-22 are rejected under 35 U.S.C. § 103 over JP-011497. According to page 3 of appellants' specification, the Japanese reference discloses ophthalmic compositions comprising glutathione and conventional auxiliaries such as appellants' wearability component, polyvinyl alcohol. Although appellants' specification states that the Japanese reference does not teach use of the composition in the care of contact lens, it is well settled that a claimed composition cannot be distinguished from the same prior art composition by recitation of an intended use not described in the prior art. As a result, we find no patentable distinction between the composition disclosed by Japanese '114 and the composition recited in appealed claim 13. As for the claimed pHs set forth in some of the dependent claims, it is also well settled

Appeal No. 96-1852
Application No. 08/016,931

that it is a matter of prima facie obviousness for the skilled artisan to ascertain the optimum conditions of pH and the like. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

In conclusion, based on the foregoing, the examiner's decision rejecting appealed claims 1-13 and 15-22 is reversed. A new ground of rejection under 37 CFR § 1.196(b) has been entered for claims 13 and 15-22.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter

Appeal No. 96-1852
Application No. 08/016,931

reconsidered by the examiner, in which event the
application will be remanded to the examiner

(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record

Appeal No. 96-1852
Application No. 08/016,931

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED - 37 CFR § 1.196(b)

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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Appeal No. 96-1852
Application No. 08/016,931

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